



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
09-708,096	11/03/2000	Philip C. Wong	JHU1690-1	9634

7590 07/22/2003

Lisa A Haile
Gray Cary Ware & Freidenrich LLP
4365 Executive Drive Suite 1600
San Diego, CA 92121-2189

EXAMINER

NICHOLS, CHRISTOPHER J

ART UNIT	PAPER NUMBER
----------	--------------

1647

DATE MAILED: 07/22/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/708,096

Applicant(s)

WONG ET AL.

Examiner

Christopher Nichols, Ph.D.

Art Unit

1647

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 7 Jly 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1 and 70-75

Claim(s) withdrawn from consideration: _____

ELIZABETH KEMMERER
PRIMARY EXAMINER

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: (a) claims 1 and 70-75 were rejected in Paper No. 10 (5 March 2003) as noted in the previous Office Action and the accompanying PTO-326 and thus was clearly stated in said Office Action, (b) Yan et al. (2001) and Vassar et al. (2001) were used in the previous Office Action to demonstrate that anti-BACE antibodies do not necessarily have the activity as claimed, (c) the Specification only offers prophetic discussions of anti-BACE1 monoclonal antibodies (pp. 26) and antisera (Example 2). The Specification does not provide any examples, guidance, support, or discussion of which epitopes or what manner of antibody is required to practice the method of claim 1. While the Examiner accepts the Applicant's citations of the state of the art of BACE1, no discussion is present in the Specification as filed as to guide the skilled artisan in using the information to practice the invention. The Applicant also argues that routine screening of antibodies could yield antibodies for use in the claimed method. However, as evident from Yan et al. (2001) and Vasser et al. (2001), there is no predictability the antibodies so isolated would have the activity necessary to fulfill the preamble of claim 1. Therefore the rejection of claim 1 and claims 70-75 as set forth in the previous Office Action (Paper No. 10, 5 March 2003) is maintained.